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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/417,266	10/12/1999	SAMUEL GEORGE MAROPIS	8285/238	7233

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GENERAL NUMBER 00757
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EXAMINER

FOSTER, ROLAND G

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 04/23/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/417,266	MAROPIS ET AL.	
	Examiner	Art Unit	
	Roland G. Foster	2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 16-19 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 16 is/are rejected.
- 7) ☒ Claim(s) 17-19 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
 a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>28</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on September 09, 2003 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various

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claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary.

Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 4, 5, 8-11, and 16 rejected under 35 U.S.C. 103(a) as being unpatentable over the White Paper on Prepaid Local Phone Services Present by the National ALEC Association by Hazam, dated August 1999, by Hazam et al. ("Hazam"), of record, in view of U.S. Patent Application Publication No. 2002/0026418 A1 to Koppel et al. ("Koppel"), newly cited.

With respect to claim 1, see the following paragraphs for details on how Hazam anticipates particular limitations within the claim. The limitations not addressed are clearly disclosed by Hazam.

The limitation "identifying a prepaid subscriber account in a prepaid local telephone call database for the subscriber based

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on the telephone number of the subscriber" reads on Hazam as follows. The telephone number of the subscriber is used to generate a billing record by the incumbent local exchange carrier (ILEC) for the prepaid carrier (page 6, "F. Billing", page 8, "3. Changing of Preassigned Phone Numbers", and page 9, "3. Overcharging for Service to a Suspended or Disconnected Customer"). Therefore, billing data for the subscriber (i.e., a subscriber account) is identified based on the telephone number of the subscriber. The ILEC relies upon a database to perform prepaid functions (page 5, "C. Access to Operations Support Systems") such as the competitive local exchange (CLEC) Electronic Interfaces and the Local Carrier Service Center (LCSC) (page 9, "1. Excessive Blocking, Testing, and OSS Charges). Therefore, the prepaid account is identified in a database.

The limitation "determining the period of prepaid service for the identified subscriber network" reads on page 3, "A. How Prepaid Local Carriers Provide Service" where the period of service is monthly.

The limitation "monitoring the period of prepaid service at the local prepaid telephone call database independently of a

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duration of any prepaid telephone call made during the period of prepaid service" reads on Hazam where the system charges on a monthly flat rate and also avoids all per-call and per-minute charges (page 3, "A. How Prepaid Local Carriers Provide Service"). Therefore, the monthly prepaid period is monitored independently of call duration.

Hazam fails to disclose: 1) receiving a value identification code and 2) sending termination date information to the subscriber prior to an expiration of the period of prepaid service.

However, regarding issue 1), Koppel (similarly to Hazam) teaches of a prepaid card system (abstract) that receives a prepaid card "code" (or number) from the user that is used to "identify" the "value" in the user's prepaid account (i.e., a value identification code) (paragraph 0050).¹

¹ This interpretation of the claimed "value identification code" reasonably broad consistent with the applicant's specification. Specifically, the specification discloses that a value identification number (code) is a card number associated with the prepaid card that is used by the prepaid system to identify the value in the user's account (page 11, lines 16-27).

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Regarding issue 2) Koppel also teaches sending termination date information to the subscriber prior to an expiration of the period of prepaid service (col. 4, claims 1-3).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to add 1) receiving a value identification code and 2) sending termination data information prior to expiration as taught by the prepaid card system of Koppel to the prepaid card system of Hazam.

The suggestion/motivation for doing so would have been to increase the versatility and flexibility of a prepaid card by associating a number on the card with an account so that the card can be used and easily linked to an account. This is especially so in prepaid cards, which are sold at stores and lack any identification as to the owner of the card. Indeed, the use of value identification codes on different types of financial cards (e.g., credit cards, calling cards, debit cards, etc.) in order to link the card to an account would have been notoriously well known in the art of financial card systems. In addition, warning the user that the card will expire would have increased the versatility and user-friendliness of a pre-paid

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card by reminding the user to use the prepaid card before it expires. The concept of notifying the user that their card will expire would have been well known in the art as a method to retain customers and to increase business revenues. For example, it would have been routine industry practice to send reminder messages in the mail or by telephone calls to subscribers that their card is about to expire and then offering the subscriber a chance to renew. Therefore, sending the reminder messages by another form of mail, specifically e-mail, would have conformed to routine industry practices.

Claim 8 differs substantively from claim 1 in that claim 8 recites a telephone network that performs the functions equivalent to the methods performed in claim 1. Therefore, see the claim 1 rejection for additional details. Claim 8 also contains the following limitations.

The limitation "a prepaid local telephone call service center in communication with at least one local exchange carrier" reads on Hazam where directory assistance calls made on the local exchange are routed (communicated) to an alternate operator services provider (prepaid service center) (page 6, "A. Blocking Issues"). Also as discussed above, the CLEC LCSC

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(prepaid service center) is also in communication with the local exchange network in order to perform prepaid call functions.

The limitation "an application server having a processor and a subscriber database" reads on Hazam where the operations support system comprises computer systems and databases (page 5, "C. Access to Operations Support Systems").

Claim 8 also recites that the system monitors the service period without monitoring for the "dollar value of the individual telephone calls" which reads on the flat-rate service, per monthly service for local calls as disclosed by Hazam (see the claim 1 rejection for further details).

Claim 16 substantively differs from the previously discussed claims in the claim 16 recites that "a reminder message" is sent to the subscriber prior to expiration which reads on the Internet reminder message disclosed by the combination of Hazam in view of Koppel. Claim 16 also recites sending a "suspend message" comprising "an instruction to suspend local telephone service for the subscriber" which reads Hazam, page 9, "3. Overcharging for Service to a Suspended or Disconnected Customer."

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With respect to claims 4, 5, and 9-11, see page 9, "3.
Overcharging for Service to a Suspended or Disconnected
Customer."

Claim 2 is rejected under 35 U.S.C. 103(a) as being
unpatentable over Hazam in view of Koppel as applied to claim 1
above, and further in view of U.S. Patent No. 5,762,376 to
Taskett, as used in the previous Office action.

Although Hazam discloses a prepaid, service center (as
discussed above), Hazam as modified fails to disclose that voice
recognition is used at the service center.

However, Hazam discloses of a similar telephone service
system supporting prepaid card (abstract and Fig. 1) that uses
voice recognition (col. 8, lines 10-15).

Therefore, it would have been obvious to a person of
ordinary skill in the art at the time the invention was made to
add the voice recognition as taught by the prepaid service
center of Taskett to the prepaid service center disclosed by
Hazam in view of Koppel.

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The suggestion/motivation for doing so would have been to increase user-friendliness and flexibility by allowing the subscriber to enter information by speaking in addition to entering information on a telephone keypad. Additionally, the concept of a voice response unit that allows users to either speak or use a telephone keypad, such as "Press or speak 1 for savings" is notoriously well-known in the art.

Claim 3, 6, 7, 12, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hazam in view of Koppel as applied to claims 1, 4, 8, and 16 above, and further in view of U.S. Patent No. 5,946,30 to Cohen et al. ("Cohen"), as used in the previous Office action.

Although the combination of Hazam in view of Koppel discloses sending an expiration warning, Hazam fails to specifically disclose that the expiration warning also includes a grace period with an offer to renew where the service is cancelled if the grace period is exceeded.

However, Cohen (similarly to Hazam) teaches of prepaid, telephone card processing system where the user is sent a

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renewal reminder message prior to service expiration with an offer to renew and where the service is cancelled if the grace period is exceeded (col. 4, line 63 - col. 5, line 60).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to add sending a renewal reminder message prior to service expiration as taught by the prepaid, telephone card processing system of Cohen to the prepaid, telephone card processing system disclosed by Hazam in view of Koppel.

The suggestion/motivation for doing so would have been to increase customers and business revenue by warning the user that that their card is about to expire and then offering the subscriber a chance to renew during a grace period thus retaining the customer and potential future revenues. The grace period would have also increased user-friendliness by not abruptly terminating the user's call. Finally, canceling the service after the grace period would have increased revenue by preventing a user from fraudulently using the grace period to extend the service indefinitely.

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Allowable Subject Matter

Claims 17-19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Examiner's Reasons for Indicating Allowable Subject Matter

Dependent claim 17 recites features directed to measuring the grace period from when the suspend message is sent. Dependent claim 18 recites limitations directed to permitting emergency calls during the inactive state.

The prior art of record fails to teach or fairly suggest adding the above features to the combination of Hazam in view of Koppel in order to arrive at the invention as claimed by the applicant.

The above reasons for allowance are based on the claims as presently set forth in their totality. The above reasons for allowance should not be interpreted as indicating that amended claims broadly reciting certain limitations discussed in the above reasons for allowance would be allowable. A more detailed reasons for allowance may be set forth in a subsequent Notice of

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Allowance if and when all claims in the application are put into a condition for allowance.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roland Foster whose telephone number is (703) 305-1491. The examiner can normally be reached on Monday through Friday from 9:00 a.m. to 5:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan S. Tsang, can be reached on (703) 305-4895. The fax phone number for this group is (703) 872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to customer service whose telephone number is (703) 306-0377.



Roland G. Foster
Patent Examiner
November 17, 2003